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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/506,335	09/02/2004	Eiko Kato	Q68931	8830

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WASHINGTON, DC 20037

EXAMINER

GRAHAM, SHELLEY R

ART UNIT	PAPER NUMBER
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4173

MAIL DATE	DELIVERY MODE
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01/11/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/506,335

Applicant(s)

KATO ET AL.

Examiner

SHELLEY R. GRAHAM

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date See Continuation Sheet.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :3 pages, 02 Sep 2004 and 5 pages, 29 Mar 2006.

DETAILED ACTION

Status of the Application

Applicants' preliminary amendment filed 29 March 2006 and Information Disclosure Statement filed 29 March 2006 have been received and entered into the application. Accordingly, Claim 15-17 have been amended. Claims 1-17 are being examined on their merits.

Claim Rejections - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 and 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by TAKATA et al., J. Pharm. Sci. (1994), Vol. 84, No. 1, pages 96-100.

TAKATA et al., disclose the composition of aminoalkylcarboxylate esters of tocopherol and the hydrochloride salt on page 97. See compounds 2-10 and Table 1. The instant claims are drawn to "a whitening cosmetic composition." However, under the US patent practice intended use is not a limitation in a compound or composition claim. *In re Hack*, 114USPQ 161 (CCPA, 1957); *In re Craig*, 90 USPQ 33 (CCPA, 1951); *In re Brenner*, 82 USPQ 49 (CCPA, 1949).

Accordingly, Claims 1-6 and 11-13 are deemed properly rejected as being anticipated by TAKATA et al. who teach of the instantly claimed composition

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Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

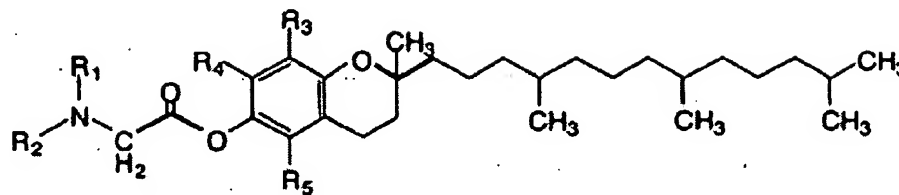
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over GORDON et al. (USPN 5,932,612).

The claims of the instant application are drawn to a cosmetic composition characterized by comprising a tocopherol alkylglycine ester and/or a salt thereof (claim 1). Further limitation draws the invention to compounds represented by formula (1) (claim 2):

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wherein R_1 and R_2 represent the same or different lower alkyl group or a hydrogen atom;
and R_3 , R_4 , and R_5 represent a hydrogen atom or a methyl group; with the proviso that R_1 and R_2
do not represent a hydrogen atom at the same time.

Additionally, the claims are further limited to the α -, dl- α -, d- α -, γ -, d- γ -, δ - and d- δ -forms of tocopherol alkylglycine ester (claims 3-10); tocopherol dimethylglycine ester (claim 11); the organic or inorganic acid salt of tocopherol alkylglycine ester, namely the hydrochloride salt (claims 12-13); wherein the added amount of the tocopherol alkylglycine ester and/or salt thereof ranges from 0.1 to 10% by mass (claim 14). The composition is a composition which use is to prevent or eliminate pigmentation of the skin.

GORDON et al. teaches of a compositions useful for treating hyperpigmentation once it has occurred, as well as in the prevention of hyperpigmentation. The composition of GORDON et al. comprises tocopherol or a dermally available derivative thereof, a dermally available derivative of ascorbic acid, a C12-C20 fatty acid, a pharmaceutically acceptable carrier and hydroquinone (claim 1). GORDON et al. define a dermally available derivative of tocopherol as a compound that makes tocopherol or a biological active form of tocopherol available to the skin (see column 1, lines 57-60).

The amount of tocopherol or its dermally available derivatives present in the composition is about 0.05 to about 10% by weight, based on the total weight of the composition (claim 22). Finally, GORDON et al. teach of a method of treating hyperpigmentation comprising

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administering an effective amount of the composition to the skin of a person in need of such treatment.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHELLEY R. GRAHAM whose telephone number is (571)270-1563. The examiner can normally be reached on M-R 8am-3pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SRG
12 December 2007


ARDIN H. MARSCHEL
SUPERVISORY PATENT EXAMINER